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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/710,705

07/29/2004

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EXAMINER

WEST, THOMAS C

ART UNIT

PAPER NUMBER

3621

MAIL DATE

DELIVERY MODE

06/05/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/710,705	Applicant(s) ABE, TOSHIYASU	
	Examiner THOMAS WEST	Art Unit 3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 March 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of Claims

1. This action is in reply Arguments/Remarks filed on March 26, 2008.
2. Claims 1-37 are currently pending and have been examined.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-3, 5-11, 13-15, 17-26, 28-37 are rejected under U.S.C. 103(a) as being unpatentable over Downs et al., US Patent No. 6,226,618 ("Downs ") in view of Fritsch, US Patent No. 6, 233,682 ("Fritsch").

Claims 1, 13, 24:

Downs, as shown, discloses authorizing purchaser and distributing a portion of sale to registered entities associated with any certain works that were copied (see at least column 2, lines 35-39).

Downs discloses the limitations as shown above. Downs does not directly disclose a purchaser of a medium or recording on the medium or authorization to

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copy made after purchase of the recording media, but Fritsch teaches (see at least column 4, lines 16-19, column 5, lines 58-65, column 5, lines 66-67 and column 6, lines 1-19).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Downs to include the purchasing and recording of Fritsch since this allows the consumer, for example, to buy the rights to copy music as well as purchase the media for doing so on the same website as well as purchase the media for doing so on the same website and authorize copying after a purchase to insure no illegal copies are made and for the convenience of producing copies from a kiosk.

Claims 2, 3, 14, 15, 25, 26:

Downs, as shown, discloses recoding media (see at least column 4, lines 1-3).

Claims 5, 6, 17, 18, 28, 29:

Downs, as shown, discloses a unique identifier (see at least column 22, lines 9-13).

Claims 7, 19:

Downs, as shown, discloses authorizing purchaser (see at least column 7, lines 56-65).

Claims 8, 20:

Downs, as shown, discloses retrieve works from a database and store them on a medium (see at least column 19, steps 138, 143).

Claims 9, 21:

Downs, as shown, discloses receiving identifier, purchaser information, and award (see at least column 22, lines 9-13, column 75, lines 20-22, column 45 lines 53-60, column 75, lines 1-20).

Claims 10, 11, 22, 23, 34, 35:

Downs, as shown, discloses registered entities (see at least column 9, lines 27-32).

Claims 30, 33:

Downs, as shown, discloses data entry, identifier, authorization (see at least column 75, lines 1-20, column 75, lines 51-67, column 10, lines 50-60, column 11, lines 40-48).

Claim 31:

Downs discloses the limitations as shown above. Downs further discloses a database and approved identifier (see at least column 9, lines 5-7, column 11,

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lines 40-48). Downs does not directly disclose a blank medium, but Fritsch teaches (see at least column 4, lines 16-19, column 5, lines 58-65).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Downs to include the blank medium of Fritsch since this allows the consumer, for example, to buy the rights to copy music as well as purchase the media for doing so on the same website.

Claim 32:

Downs, as shown, discloses a webpage and database (see at least column 75, lines 1-20).

Claims 36, 37:

Downs discloses the limitations as shown above. Downs further discloses registered entities and distributing a portion of compensation to registered entities associated with any certain works that were copied (see at least column 2, lines, lines 35-39, column 9, lines 27-32). Downs does not directly disclose distributing a recording medium, but Fritsch teaches this (see at least column 4, lines 16-19, column 5, lines 58-65). Fritsch further teaches, authorization to copy is made after purchase of the recording media (see column 5, lines 66-67 and column 6, lines 1-19).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Downs to include the recording medium and authorization

to copy after purchase of media of Fritsch since this allows the consumer, for example, to buy the rights to copy music as well as purchase the media for doing so on the same website and authorize copying after a purchase to insure no illegal copies are made and for the convenience of producing copies from a kiosk.

5. Claim 12 is rejected under U.S.C. 103(a) as being unpatentable over Downs et al., US Patent No. 6,226,618 ("Downs ") in view of Fritsch, US Patent No. 6, 233,682 ("Fritsch"), in further view of Schneier, US Patent Application No. 2003/0177347 ("Schneier").

Claim 12:

Downs/Fritsch disclose the limitations as shown above. Downs/Fritsch do not directly disclose a charitable organization, but Schneier teaches (see at least paragraph 465).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Downs/Fritsch to include the charitable organization of Schneier since this allows an artist or author to a portion of revenues to a charity of their choice.

6. Claims 4, 16, 27 are rejected under U.S.C. 103(a) as being unpatentable over Downs et al., US Patent No. 6,226,618 ("Downs ") in view of Fritsch, US Patent No. 6,

233,682 ("Fritsch") and in further view of Ferandez-Molina, The Moral Rights of Authors in the Age of Digital Information ("Ferandez").

Claims 4, 16, 27:

Downs/Fritsch disclose the limitations as shown above. Downs/Fritsch do not directly disclose a written authorization Ferandez teaches (see at least page 113, column 2, paragraph 5).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Downs/Fritsch to include the written authorization of Ferandez since this provides the customer with authorization to copy an artistic work.

Response to Arguments

5. Applicant's arguments filed March 26, 2008 have been fully considered but they are not persuasive. Applicant's arguments will be addressed in sequential order as they were set forth in the "Remarks" section. Applicant argues that neither Downs nor Fritsch teach or suggest a purchaser is authorized to make copies after they have purchased a recording medium. Fritsch explicitly teaches, "After confirming the receipt of payment, the product is delivered to the consumer. The delivery 26 is carried out by downloading the purchased digital music or text/graphics of the purchased information", col. 6, lines 9-12.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas West whose telephone number is 571-270-1236. The examiner can normally be reached on M-R 7:30am - 5pm EST, ALT Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Fischer can be reached on 571-272-6779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

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For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Thomas West
Patent Examiner
Art Unit 3621
June 1, 2008

/ANDREW J. FISCHER/
Supervisory Patent Examiner, Art Unit 3621